

art. The copyright notice on the Wanthal document does not mean that the document was published, either. There is no registration requirement for putting such a notice on a document. Applicant submits that the notice merely indicates ownership of the material contained therein. The notice is not an admission by the author that the document was made publically available within the meaning of 35 USC 102.

Applicant informs the Examiner that the issue as to whether Wanthal is prior art is also currently before Examiner Gladys Corcoran in regard to S.N. 09/946,627, filed 08/31/01 and Examiner Sing P. Chan in regard to S.N. 09/898,633, filed 07/02/01.

Whether a document constitutes a "printed publication" under 35 U.S.C. § 102(b) is a question of law based upon underlying fact issues. *See Northern Telecom Inc. v. Datapoint Corp.*, 908 F.2d 931, 15 USPQ2d 1321 (Fed. Cir. 1990). This legal determination is decided on a "case-by-case" basis. *See In re Hall*, 781 F.2d 897, 228 U.S.P.Q. 453 (Fed. Cir. 1986).

The touchstone of the "printed publication" analysis is public accessibility. *See In Re Tenney*, 254 F.2d 619, 117 USPQ 348 (CCPA 1958). *See also Aluminum Co. of America v. Reynolds Metals Co.*, 14 USPQ2d 1170 (N.D. Ill. 1989). Information is considered publicly accessible if any person skilled in the art who is concerned with or interested in the subject matter to which the publication relates, could have access to the documents and avail themselves of the information contained therein by the exercise of reasonable diligence. *See id.* *See also In re Hall*, 781 F.2d 897, 228 USPQ 453 (Fed. Cir. 1986). *See also In re Wyer*, 655 F.2d 221, 210 USPQ 790 (C.C.P.A. 1981). *See also Northern Telecom Inc. v. Datapoint Corp.*, 9 USPQ2d 1577 (N.D. Tex. 1988), *aff'd in part, rev'd in part*, 908 F.2d 931, 15 USPQ2d 1321 (Fed. Cir. 1990).

In general, a distribution to a limited group with an injunction to secrecy is not a publication. *See Northern Telecom Inc. v. Datapoint Corp.*, 9 USPQ2d 1577 (N.D. Tex. 1988), *aff'd in part, rev'd in part*, 908 F.2d 931, 15 USPQ2d 1321 (Fed. Cir. 1990). In *Northern Telecom*, documents were prepared as part of a government project. They were distributed to at least 50 commercial and private individuals and companies involved in the project. There was evidence, however, that such distribution may have been made with a restrictive notice on the documents. Although the documents were contained in a library at a specific corporation and were not classified, access to the library was restricted only to persons authorized by the corporation to use the library. The Federal Circuit held that because there was no evidence that anyone could have had access to the documents by the exercise of reasonable diligence, it was not a "printed publication" under the statute. *See id.*

Further, in *Ex parte Kroenert*, 144 USPQ 133 (Pat. Off. Bd. App. 1960), a United States military specification was listed in an "Index of Specifications." The Index was on sale to the public. Nevertheless, the Board held that the specification itself was not a "printed publication" under the statute. Advance permission was needed to obtain access to the specification, and there was no indication that "any technically or scientifically qualified person could have had a copy ... merely for the asking." *Ex parte Kroenert*, 144 USPQ 133 (Pat. Off. Bd. App. 1960).

Even an inherently understood, albeit silent, limitation on access can operate as an effective restriction. *See Aluminum Co. of America v. Reynolds Metals Co.*, 14 USPQ2d 1170 (N.D. Ill. 1989). In *ALCOA*, the patentee, under terms of a contract with a government agency, periodically distributed a progress letter to 33 entities in and outside government, including aluminum producers, aircraft manufacturers, government agencies, branches of the military and academic researchers. The government agency initially required the patentee to stamp the

reports "Distribution of This Report is Unlimited." It later changed its mind and directed the patentee to label the letters with the following "export control" notice:

"This Document is Subject to Special Export Controls and Each Transmittal to Foreign Governments or Foreign Nationals May Be Made Only With Prior Approval of the Naval Air Systems Command." *See id.*

In *Aluminum Company*, the issue arose whether one of the progress letters distributed to the designees with the export control notice constituted a printed publication. The district court held that it did not. It conceded that at "first glance" the letters did appear to meet the public accessibility test of publication, by stating that "thirty-three copies were made and distributed, and not just to government groups ... Thirteen nongovernmental companies and individuals received copies too ... including big commercial competitors like Kaiser and Reynolds." In addition, only the export control notice put any explicit restriction on distribution beyond the initial thirty-three, and by its terms, that notice did no more than limit access to United States citizens, of whom there are more than 220 million—scarcely the sort of restriction that should ordinarily prevent a document from being classified as a "printed publication" under the statute. In addition, there was no evidence in the record that access was ever denied to anyone who sought it. *See id.*

Nevertheless, the court found that the letters were not accessible to the public in fact because all the designees treated the letters as confidential and not for further distribution. The court stated that virtually everyone who received the Third Progress Letter treated it as if it had been marked confidential. For example, Reynolds never circulated the copy it received to anyone outside its organization, and Kaiser went so far to keep its copy in a protected area,

screened even from some of its own employees. The court summarized: "In sum, the evidence does not show that the Third Progress Letter was ever treated as a publication. Instead, it suggests that within defense industry circles, the practice was to keep documents stamped with export control notices under wraps." *See id.*

To summarize, in *Northern Telecom*, restrictive notices were placed on the documents. In both *Northern Telecom* and *Ex parte Kroenert*, restrictions on access to the documents existed, including requirements of advance authorization to review the documents. In *ALCOA*, the documents included export control notices, invoking a defense industry practice to keep documents under such export controls confidential.

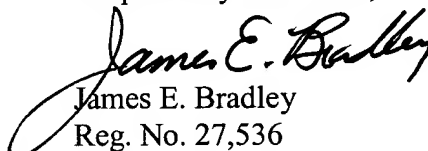
Similarly, in the case at hand, a report was given orally at a conference primarily for government officials and government contractors. There's no evidence that the report was given out to the participants at the conference. The meeting was a "Closed Session," and access restrictions prohibited persons from attending the session unless they complied with Department of Defense requirements. Further, the paper contained a conspicuous warning, similar to the *Alcoa* case discussed above to alert readers that the document contains technical data whose export is restricted by Federal Law.

Therefore, applying these facts to the law as stated in *Northern Telecom*, *Ex parte Kroenert*, and *ALCOA*, applicant submits that Wanthal is not a printed publication because it was not accessible by the general public. There is no evidence that with the exercise of reasonable diligence, any person skilled in the art who is concerned with or interested in the subject matter to which the publication relates, could have access to the documents and avail themselves of the information contained therein.

Furthermore, the Wanthal paper does not establish that the invention was known by others in this country before the invention by the applicant within the meaning of 35USC102(a). If the Wanthal paper is not a printed publication under 102(b), the oral presentation at a restricted conference cannot be considered to be evidence known by others; otherwise, the *Northern Telecom*, *Ex parte Kroenert*, and *Aluminum Company* cases would have held oppositely. To be known, the information must have been accessible to those who might be interested in the subject matter. As stated in the attached declaration, however, countless others may find this information to be of interest. The composite fabrication techniques of this application are applicable to many industries besides military aircraft construction.

The Wanthal paper was the primary reference used to reject the claims in Sections 7-11. Applicant respectfully requests the Examiner to withdraw Wanthal as a reference for the purposes of an appeal.

Respectfully submitted,

  
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